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EXAMINER

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ART UNIT PAPER NUMBER

1755

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/666,951
Filing Date: September 20, 2000
Appellant(s): BECKMANN, FRIEDHELM

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Markus Nollf Reg. No 37,006

For Appellant

EXAMINER'S ANSWER

MAILED
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GROUP 1700

This is in response to the appeal brief filed March 31, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-18.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-18 do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 10 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification teaches that the solid core material is coated with activatable material but fails to define "activatable material" (page 3, line 14).

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, the term "activatable material" does not reference a substance. What is meant by "activatable material"? The specification does not teach what this material is.

Composition claims were held to be indefinite for being defined in terms of properties alone. *Ex Parte Slob* 157 USPQ 172 (PO BdPatApp 1967).

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Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 5,194,199) in view of Soderberg (US 5,160,465).

Thum discloses a method of producing a structural beam with a coated core material of aluminum foam (col. 2, lines 37). Thum fails to teach the processing steps whereby corrosion treatment is separate and prior to the expansion of foam step. Soderberg teaches a process of insulating a body cavity comprising the assembly having a corrosion treatment-separate and prior to expansion of the foam (col. 2, lines 66-col. 3, lines 14). Thum teaches the article and Soderberg discloses a process, which would be used to produce an article of the same. Therefore, one of ordinary skill in the art at the time of appellant's invention would apply the processing steps of Soderberg, whereby the corrosion treatment step is prior to expansion of the foam step, to the invention of Thum in order to produce a closed article that has an anti-corrosive, and reinforced interior.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 5,194,199) and Soderberg (US 5,160,465) in view of Russell (WO 93/05103).

Thum discloses a beam like structural part having a core of lightweight material comprising polyurethane or aluminum foam (fig.1, col. 2, lines 17-19) and Soderberg teaches a process of insulating a body by submitting the body to anti-corrosion treatment and then to a high temperature curing treatment whereby the foaming material expands and adheres to the surrounding metal surface and forms a sound and moisture insulating plug of closed-cell foam (col.3, lines 2-10). Neither Thum nor Soderberg teach the activatable material to be a foamed/unfoamed metallic material, or synthetic material reinforced with fibers.

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However, Russell teaches the activatable material to be a mixture of plastic materials and reinforcing fibers (page 1, lines 34-39) for the purpose of reinforcing a structure. In addition the reference teaches strengthening only in some areas for the purpose of structural integrity (page 3, lines 6-7). Therefore, it would have been obvious to one of ordinary skill in the art to combine the structural body of Thum, comprising a hollow member for insulation, with the process of insulating the body as taught by Soderberg with the activatable foamable material and the method of strengthening portions as taught by Russell to create a body comprising a hollow section that has internal reinforcement in full or parts in order to improve the performance of the structure.

(11) Response to Argument

Argument with respect to the 35 U.S.C. 112 rejections

Appellant argues that, "the activatable material disclosed in the specification refers to material which is activatable to foam, and if activated, form foam. In other words, the activatable material disclosed in the specification is activatable foamable material". Appellant's argument addresses the written description aspect of 35 U.S.C. 112, first paragraph, however the rejection is based on the enablement aspect of 35 U.S.C. 112, first paragraph. Appellant's argument does not address the enablement rejection.

The activatable foamable material is not clearly taught so that one of ordinary skill in the art would recognize what substance appellant considers as the invention. Specific materials are neither identified in the specification nor claimed. One of ordinary skill in the art can not read appellant's preferred embodiment into the claims thus, it can not be

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assumed that the activatable foamable material is limited to those known to be used in the automotive industry. There is nothing on the record to indicate that any known activatable foamable material can be used in the claimed hollow section thus, one of ordinary skill in the art cannot make this assumption. Accordingly, one of ordinary skill is given no guidance as to what substance appellant considers being activatable foamable material. Appellant's argument with respect to 112, second paragraph, rejection is that *Ex Parte Slob* is not cited in the MPEP. Appellant's apparent position is that the only case law that can be cited is that codified in the MPEP. It appears to be Appellant's position that *Ex Parte Slob* is not case law since it is not cited in the MPEP. The Appellant's position is incorrect especially since any case that is cited in the USPQ and which has not been overturned by a court of law is valid case law. *Ex Parte Slob* has not been overturned. The case law cited by Appellant is irrelevant since it only addresses 35 U.S.C. 112, first paragraph written description requirement, and not the rejection at hand.

Argument with respect to Art Rejections

Appellant's argue that, Soderberg does not teach the step of "subjecting all interior areas of the assembly to a corrosion protection agent", and that, "if the interior areas of the assembly in Soderberg would be subject to anti-corrosion treatment, then it would not be necessary to use a non-moisture-absorbing foam to minimize corrosion". This is not convincing for the following reasons:

Soderberg discloses submitting the vehicle to low temperature anti-corrosion treatment (col. 3, lines 1-10). One of ordinary skill would deem the vehicle to contain an interior and


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an exterior, thus by submitting the vehicle to treatment; one would be applying treatment to the exterior as well as the interior. The fact that Soderberg uses non-moisture absorbing foam does not indicated that the total vehicle is not treated especially since col. 3, lines 3-5 and col. 5, lines 4-6 teach treating all exposed metal parts which would include the interior of the vehicle.

Appellant's argument with respect to combining the references is that Soderberg teaches away from subjecting the interior areas of the assembly to anti-corrosion treatment.

This argument is not convincing for the above reasons.

Respectfully submitted,


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June 1, 2003

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